

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Vyacheslav Barsuk

Application No.: 10 / 736,429

Group No.: 2116

Filed: 12/15/2003

Examiner: Michael J. Brown

For: METHOD, APPARATUS AND PROGRAM STORAGE DEVICE FOR PROVIDING REMOTE POWER RESET AT A REMOTE SERVER THROUGH A NETWORK CONNECTION

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

DECLARATION OF PRIOR INVENTION IN THE UNITED STATES
OR IN A NAFTA OR WTO MEMBER COUNTRY
TO OVERCOME CITED PATENT OR PUBLICATION (37 C.F.R. § 1.131)

NOTE: 37 C.F.R. § 1.131 Affidavit or declaration of prior invention.

(i) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(a). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

- ☐ deposited with the United States Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10*

- ☒ with sufficient postage as first class mail.

- ☐ as "Express Mail Post Office to Addressee"

Mailing Label No. _____ (mandatory)

TRANSMISSION

- ☐ facsimile transmitted to the Patent and Trademark Office, (571) 273-8300.

Signature

Georgia Y. Brundage

(type or print name of person certifying)

* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(f)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

(Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome Cited Patent or Publication—37 C.F.R. § 1.131 [9-32]—page 1 of 5)

(2) The rejection is based upon a statutory bar.

PURPOSE OF DECLARATION

1. This declaration is to establish completion of the invention of this application in
- ☒ the United States
 - ☐ the NAFTA country _____ (name of country)
 - ☐ the WIPO country _____ (name of country)
- at a date prior to June 30, 2003, that is the effective date of the prior art
- ☐ publication _____
 - ☐ patent _____
 - ☒ patent publication US 2004/0267918 A1
 - ☐ other _____
- that was cited by the
- ☒ examiner.
 - ☐ applicant.

NOTE: 37 C.F.R. § 1.131 is not applicable to a rejection based on a U.S. patent that CLAIMS the rejected invention.

2. The person making this declaration is (are):
- ☒ the inventor(s).
 - ☐ only some of the joint inventor(s) (and a suitable excuse is attached for failure of the omitted joint inventor(s) to sign)
 - ☐ the party in interest (and a suitable explanation as why it is not possible to produce the declaration of the inventor(s) is attached)

FACTS AND DOCUMENTARY EVIDENCE

NOTE: "The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained." 37 C.F.R. § 1.131(b).

(Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome

Cited Patent or Publication—37 C.F.R. § 1.131 [P-32, page 2 of 5])

"I conceived and reduced to practice the invention, as currently claimed, by March 2003. This is evidenced by invention disclosure ENDR-2003-0065 submitted by me on May 7, 2003, the source code listing for "res.c" (implemented at a calling computer), the source code listing for "rescl.c" (implemented at the remote computer which is called by the calling computer), and the dir list.txt directory (which indicates last date of update of "res.c" and "rescl.c" source code programs). I recently added comments to the res.c and rescl.c source code for explanatory purposes, and these comments accurately reflect the function of the respectively steps in the source code."

3. To establish the date of completion of the invention of this application, the following attached documents and/or models are submitted as evidence:

(check all applicable items below)

- ☐ sketches
- ☐ blueprints
- ☐ photographs
- ☐ reproduction(s) of notebook entries
- ☐ model
- ☐ supporting statement(s) by witness(es) (where verbal disclosures are the evidence relied upon)
- ☐ interference testimony rescl.c (source code)
dir list.txt (directory)
- ☒ disclosure documents Disclosure EMD6-2003-0065
rescl.c (source code)

NOTE: While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Morgenthaler v. Scudder* 1897 C.D. 724, 81 O.G. 1417. See also M.P.E.P. § 715.07 and § 2138.04, 7th ed.

4. From these documents and/or models, it can be seen that the invention in this application was made

- ☐ on _____
- ☒ at least by the date of March 31, 2003, which is a date earlier than the effective date of the reference.

NOTE: "If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration." M.P.E.P. § 715.07, 8th ed.

NOTE: "If the dates in the oath or declaration may be the actual dates, or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided." M.P.E.P. § 715.07, 8th ed.

DILIGENCE

NOTE: "Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of the actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, § 1.131)." M.P.E.P. § 715.07, 8th ed.

NOTE: "A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS HE OR SHE FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, Limited 1909 C.D. 498, 139 O.G. 891, M.P.E.P. § 715.07, 8th ed.

"Conception in the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Morgenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417, it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also." M.P.E.P. § 715.07, 8th ed.

NOTE: "Only diligence before reduction to practice is a material consideration. The lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947)." M.P.E.P. § 715.07(d), 8th ed.

(Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome Cited Patent or Publication—37 C.F.R. § 1.131 [9-32]—page 3 of 9)

their conception () a time just prior to the date of the refusal, up to the:

☒ actual reduction to practice.

☐ filing of this application.

TIME OF PRESENTATION OF THE DECLARATION

(complete (a), (b) or (c))

- (a) ☒ This declaration is submitted prior to final rejection.
- (b) ☐ This declaration is submitted with the first response after final rejection, and is for the purpose of overcoming a new ground of rejection or requirement made in the final rejection.
- (c) ☐ This declaration is submitted after final rejection. A showing under 37 C.F.R. § 1.116(b) is submitted herewith.

DECLARATION

6. As a person signing below:

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

(Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome Cited Patent or Publication—37 C.F.R. § 1.131 [9-32]—page 4 of 6)

SIGNATURE(S)

7.

(complete A or B below)

A. Inventor(s)

Full name of sole or first inventor Vyacheslav Barsuk
 Inventor's signature [Signature]
 Date 11/15/01 Country of Citizenship Ukraine
 Residence 2450 Airport Road, K3103, Longmont, CO 80503
 Post Office Address Same as Residence

Full name of second joint inventor, if any _____
 Inventor's signature _____
 Date _____ Country of Citizenship _____
 Residence _____
 Post Office Address _____

(use added page for signature by additional inventors)

Number of pages added: 0

B. Assignee

(type or print name of person signing)

Signature

Date

P.O. Address

(type name of assignee)

Address of assignee

Title of person authorized to sign
on behalf of assignee

Assignment recorded in PTO on _____

Reel _____ Frame _____

A "CERTIFICATE UNDER 37 C.F.R. § 3.73(b)" is attached.

(Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome
Cited Patent or Publication—37 C.F.R. § 1.131 [8-32]—page 5 of 5)